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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,972	10/31/2001	Christopher Rogers	DEP 0639	6510

27777 7590 09/30/2003  
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EXAMINER

LEWIS, RALPH A

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 09/30/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/998,972

Applicant(s)

ROGERS ET AL.

Examiner

Ralph A. Lewis

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **Objection to the Abstract**

The abstract is objected to as being written as a single sentence claim. The form and legal phraseology often used in patent claims should be avoided. The abstract should be clear and concisely describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. See MPEP 608.01(b) for guidance in drafting abstracts.

### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-14, 18, 19 and 27-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 8 and 9, line 1, it is unclear how the base "upper" and "lower" portions relate to those already set forth in the parent claim 1.

In claim 11, it is unclear how the base "upper portion" and base "lower portion" relate to the structures having the same name and already set forth in parent claim 1.

In claim 12, line 1, there is no antecedent basis for "the I-beam" (first occurrence). Moreover, the "I-beam-like shape includes an I-beam shape" limitation is confusing and not understood.

In claims 13 and 14, line 1, there is no antecedent basis for "the I-beam."

In claim 18, there is no antecedent basis for "the intermediate base portion."

In claim 19, there is no antecedent basis for the plural "secondary orthogonal shavers."

In claim 27, line 2, there is no antecedent basis for "the intermediate extending portion."

In claim 32, line 1, there is no antecedent basis for "the taper distal section."

In claims 28-37, the parent claim 27 refers to a "neck portion" and a "head portion", yet the dependent claims all refer to these structures simply as the "neck" and "head." Applicant is encouraged to use consistent terminology.

In claims 38-40, the limitation in claim 38 that the shaving portion has avertically extending portion that can apparently be no vertically extending portion (0% and dependent claim 40) is confusing and apparently meaningless. An optional limitation is no limitation at all and only serves to confuse the interpretation.

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

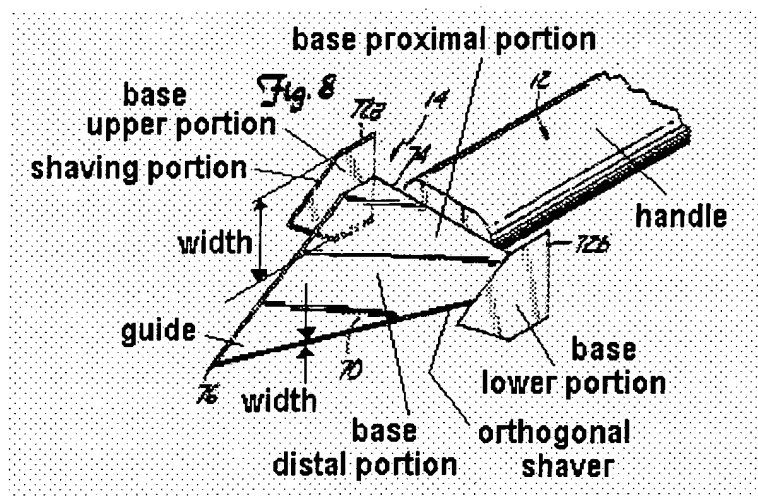
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 15, 18, 22-24 and 38-44 are rejected under 35 U.S.C. 102(a) as being anticipated by Ray et al (US 5,649,945).

Note the identified structure in Ray et al Figure 8. The intent by applicant that tool be used with base upper and lower portions in a horizontal position rather than a vertical position, fails to provide for any objectively ascertainable structural distinctions between the claimed device and that disclosed by Ray et al.



In regard to claim 4, note the optional handle of Figure 9. In regard to claim 5, note the retraction means 28 (recess).

Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Nicholson et al (US 6,241,733).

Note upper shaving portion 61 and lower shaving portion opposite thereof and secondary orthogonal shavers 64.

Claim 44 is rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent 210316.

Note Figure 8 with intermediate portion 22.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al (US 5,649,945).

The specifically claimed angles would have fallen well within a range of ordinary skill in the art would have found to be obvious.

### **Allowable Subject Matter**

The "bulging I-beam" and "bow-tie" I-beam limitations of claims 13 and 14 are interpreted as defining structure substantially as illustrated in applicant's Figures 4b and 4c and consequently deemed allowable if rewritten in independent form to include all of the limitations of the claims from which they depend and to overcome the rejections based on 35 U.S.C. 112 above. The "neck" limitation of the guide is interpreted as requiring a narrowed portion and the "head" limitation is interpreted as requiring a structure wider than the "neck", accordingly claims 19-21 and 25-37 are deemed allowable if rewritten in independent form to include all of the limitations of the claims from which they depend and to overcome the rejections based on 35 U.S.C. 112 above.


### **Prior Art**

Applicant's information disclosure statement of January 03, 2002 has been considered an initialed copy enclosed herewith.

Hamada (US 6,436,101), Foley (6,599,291) Branch et al (6,610,065) and Japanese Patent 126647 are made of record.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(703) 308-0770**. Fax (703) 872-9302. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis  
September 22, 2003



Ralph A. Lewis  
Primary Examiner  
*AU 3732*